

REMARKS

In the non-final Office Action dated August 12, 2004, the U.S. Patent Examiner states that Claim Nos. 1 – 6 and 40 – 48 are pending in the application. Claims Nos. 1 – 6 (previously stated to be allowable) and newly drafted Claim Nos. 41 – 48 are rejected for the reasons stated on Page Nos. 2 – 4 of the Office Action. No statement is presented as to why Claim No. 40 has been summarily rejected (as indicated under the Disposition of Claims section of the Office Action Summary). Clarification is kindly requested as to the status of Claim No. 40. Notably, it is difficult to fully respond to an Office Action having inconsistency between the Office Action Summary and the reasons for claim rejections.

With regard to previously withdrawn Claim Nos. 32 – 39, Applicant retains the right to file a Divisional Patent Application incorporating the withdrawn claims.

With regard to Claim Nos. 1 – 6 and 40 – 48, Applicant has incorporated certain amendments informally suggested by the U.S. Patent Examiner in a series of informal Telephone Interviews following Applicant's submission of an informal amendment consideration paper to the U.S. Patent Examiner on October 21, 2004. From a further inspection of the Office Action, Applicant takes note, with regard to Claim Nos. 1 – 6 and 40 – 48, that the U.S. Patent Examiner has stated (on Page No. 3, Paragraph No. 1) that Fuller shows a flexible strap (30) for surrounding and engaging a portion of a columnar support adjacent the columnar jack to conceal a clamping means and a stiff skirt, a skirt (15) for covering the flexible strap.

Applicant agrees that Fuller shows flexible strap (30) means, one teaching of which suggests an encircling strap member (as shown in Figure No. 3(a)). Applicant is unclear, however, as to how Fuller may be seen to teach that flexible strap (30) conceals both a clamping means and a stiff skirt, the skirt (15) for covering the flexible strap. Applicant does agree that skirt (15) may function to cover the strap (30). Applicant does not understand how strap (30) may function to cover the skirt (15). Were the strap to conceal the stiff skirt, it is unclear how the skirt would function to cover the strap. This language would seem to be inconsistent and incorrect. It would seem that the flexible strap (30) of Fuller cannot both conceal the skirt (15) and be concealed by the skirt (15) at the same time.

Applicant further notes that Williams teaches clamping means (13) for attaching a so-called strap (2) to a columnar support. However, the strap (2) of Williams is not shown to be foldable. Neither is the Fuller strap (30) shown to be foldable. The foldable strap (18) of Applicant's invention is a foldable strap. None of the prior art appears to teach this feature. The strap of Applicant's invention is foldable upon itself for covering portions of itself as well as the clamping means for both concealing and protecting the clamping means. Applicant has amended the independent claims of this application in an effort to more properly draw attention to and claim this feature (in combination with the other elements).

Furthermore, as a follow-up to certain recommendations made by the U.S. Patent Examiner during a series of informal telephone interviews following the October 21, 2004 submission (previously mentioned), Applicant submits herewith newly drafted Claim Nos. 49 – 57. With regard to newly drafted Claim Nos. 49 – 57, the U.S. Patent

Examiner is respectfully reminded of the following rule: "By disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant necessarily discloses that function, theory or advantage even though he says nothing concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter." See *In re Smythe*, 480 F.2d 1376, 178 USPQ 279, 285 (C.C.P.A. 1973).

Applicant is cognizant of various rules that prohibit the introduction of prohibitory "new matter" into an application for U.S. Letters Patent. More specifically, two statutory provisions prohibit the introduction of "new matter" into an application. The first, 35 U.S.C. § 132, relates to original applications and states that "[n]o amendment shall introduce new matter into the disclosure of the invention." The second, 35 U.S.C. § 251, relates to reissue applications and similarly states that "[n]o new matter shall be introduced into the application for reissue." The United States Patent and Trademark Office regulations further describe the prohibition of new matter as follows:

No amendment shall introduce new matter into the disclosure of an application after the filing date of the application (§1.53(b)). All amendments to the specification, including the claims, and the drawings filed after the filing date of the application must conform to at least one of them as it was at the time of the filing of the application. Matter not found in either, involving a departure from or in addition to the original disclosure, cannot be added to the application after its filing date even though supported by an oath or declaration in accordance with §1.63 or §1.67 filed after the filing date of the application. 37 C.F.R. §1.118(a).

The specific types of changes to the specification that are legally considered "new matter" are the subject of ongoing debate. For example, the CCPA has characterized the tension in construing "new matter" as follows:

New matter is a technical legal term in patent law – a term of art. Its meaning has never been clearly defined for it cannot be. The term is on par with such terms as infringement, obviousness, priority, abandonment, and the like which express ultimate legal conclusions and are in the nature of labels attached to results after they have been reached by processes of reasoning grounded on analyses of factual situations. In other words, the statute gives us no help in determining what is or is not “new matter.” We have to decide on a case-by-case basis what changes are prohibited as “new matter” and what changes are not.

In a sense, anything inserted in a specification that was not here before is new to the specification but that does not necessarily mean it is prohibited “new matter. *In re Oda*, 170 USPQ at 270 – 71.

Notably, an applicant may conform the disclosure portion of the application to the original claims or drawings without introducing “new matter”. *See, e.g., In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537, 542 (C.C.P.A. 1962) (amended disclosure based on original drawings not new matter). In such a situation, the applicant may not add material that was not present in the application when filed, but rather may amend the application to include features of the claims or drawings to enhance the clarity of the application. Similarly, the disclosure may be amended to include matter that is inherently disclosed by the original application. *In re Nathan*, 140 USPQ at 604. Thus, the following elements comprise the *prima facie* case of prohibitory new matter:

- changes made to the application disclosure
- not supported, directly or inherently, by the originally filed specification, drawings, or claims
- as interpreted by one of ordinary skill.

It is anticipated that the U.S. Patent Examiner may be inclined to find certain amendments to this application objectionable as introducing prohibitory new matter. However, the U.S. Patent Examiner is respectfully reminded that U.S. Patent Examiners are obliged to provide a reasonable basis for each element of the *prima facie* case of prohibitory new matter for a new matter rejection to be proper.

To be sure, the present amendment introduces new language and thus it is conceded that changes have been made to the application disclosure and in this regard, the first prong of the three – prong *prima facie* case of prohibitory new matter would be met.

However, as is his legal right, Applicant, in an attempt to be fully responsive to the Office Action, looked to the sum total of his application, including the claims and various drawing figures in an effort to glean additional support for the claims as newly introduced (Claim Nos. 49 – 57) so as to place the application into more proper condition for allowance. It will be noted that drawings may provide an adequate written description of the invention in the event the written disclosure portion of the application inadvertently omitted such a written description. *In re Wolfensperger* (302 F.2d 950, 133 USPQ 537 (C.C.P.A. 1962)) is an example of when the original drawings were used to provide, in part, the written description of the invention under Section 112, first paragraph. In *Wolfensperger*, the invention related to a ball-type valve used in high pressure fluid pipelines. The valve contained a shut-off member constructed of a spherical ball plug. The U.S. Patent Examiner and the Board rejected a specific claim of the patent application on the grounds that the claim was not adequately described in the specification. In particular, the claim recited a two-dimensional relationship including a “packing ring” in “untensioned condition” that included “a mean diameter corresponding approximately to the mean diameter of said camber.” *Id.*, 133 USPQ at 538.

On appeal, the CCPA reversed. The court disagreed with the Board’s statement that it was well established legal precedent that drawings alone cannot constitute a written description of the invention. In this connection, the CCPA stated as follows:

Consider for one thing, that the sole disclosure in a design patent application is by means of a drawing. Rule 153. For another thing, consider that the only informative and significant disclosure in many electrical and chemical patents is by means of circuit diagrams or graphic formulae, constituting “drawings” in the case. *Id.* at 541 – 42.

The CCPA then described the general test for determining whether a drawing can constitute an adequate written description of the invention under Section 112, first paragraph:

The practical, legitimate inquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit “new matter,” 35 U.S.C. 132, Rule 118, for the simple reason *that* what *is* originally disclosed cannot be “new matter” within the meaning of this law. If the drawing then, contains the necessary disclosure, it can form the basis of a valid claim.” *Id.* at 542.

The CCPA held that Figure 5 of the application clearly showed that the ring had a mean diameter of an annular chamber. *Id.* at 541. On this basis, the court held that the application satisfied the written description requirement. Thus, *Wolfensperger* teaches that drawings may provide the basis for subsequent amendments to the specification without producing prohibitory “new matter” therein.

In this case, the various drawing figures clearly illustrate lines of inherent structure (structural lines) otherwise unnamed and unreferenced in previous writings submitted to the United States Patent and Trademark Office in connection with this application. Certain of these structural lines have now been named and referenced in the amendments to this application. Notably, NO NEW structural lines have been introduced into the application, although a number of reference numerals and nomenclature to more properly describe certain structural lines have been newly introduced.

In an effort to increase the clarity of the newly added claims, the Applicant has more precisely defined the structural column assembly and kit that Applicant regards as his invention by utilizing the newly added nomenclature used to describe and reference inherent structure associate with various components of the structural column assembly and kit. Further, Applicant has amended his application in an effort to more properly claim his invention by referencing and defining certain structures present in the various figures as originally submitted and in this regard, Applicants contend that the added material is supported by the original disclosure, which disclosure includes Figure Nos. 1 - 11. The original disclosure clearly shows a structural column assembly and kit as currently described and claimed. It is thus argued that the U.S. Patent Examiner will be unable to meet the second prong of the three – prong *prima facie* case of prohibitory new matter. Specifically, it is believed that the newly added language is supported, directly or inherently, by the originally filed drawing Figure Nos. 1 – 11 and thus this amendment does not introduce prohibitory new matter.

The prior art perceives a need for a structural column assembly and kit as currently described and claimed. This need has lead Applicant to the filing of Application No. 09/872,899 on June 2, 2001 and has further prompted Applicant to more succinctly claim and describe the subject matter that he regards as his invention in response to the Office Action.

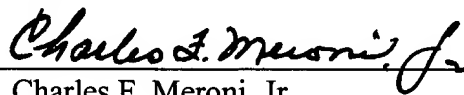
CONCLUSIONS

In light of the amendments made to Claim Nos. 1 – 6 and 40 – 48 and the inclusion of newly submitted Claim Nos. 49 – 57 along with supporting Specification amendments, the U.S. Patent Examiner is kindly requested to reconsider his rejections of

record and those he may render in consideration of the newly added claims found in this amendment. The Applicant's claimed invention is believed to differ over the prior art in view of the inclusion of certain critical language in the claims as presented by this amendment.

In view of the amendments that have been made to the claims, as well as the arguments presented herein in support of the claims, it is believed that the rejections of record are no longer appropriate and that the claims should therefore be approved for allowance. Thus, it is hoped for and believed that this application is now in more proper condition for allowance, and an action notifying Applicant of the allowability of claims is kindly requested. If, after a review of this Amendment, issues remain which may be resolved by a further telephone interview, the U.S. Patent Examiner is cordially invited to call the Applicants' undersigned attorney. . If attempts to reach the undersigned attorney are not successful, please be advised that Christopher J. Scott, Registration No. 48,647, may also be contacted with regard to this matter. Mr. Scott has been in regular communication with the undersigned regarding the most recent Office Action and this Amendment. Further, Mr. Scott is listed under our firm's Customer Number with the United States Patent and Trademark Office, namely, Customer Number 30114, and thus may be deemed a proper legal representative of Applicant.

Respectfully submitted,
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IN THE DRAWINGS

Amended drawing sheets, namely, Figure Nos. 1 – 11 are separately attached herewith. In this regard, replacement sheets and annotated copies are presented for the U.S. Patent Examiner's inspection.

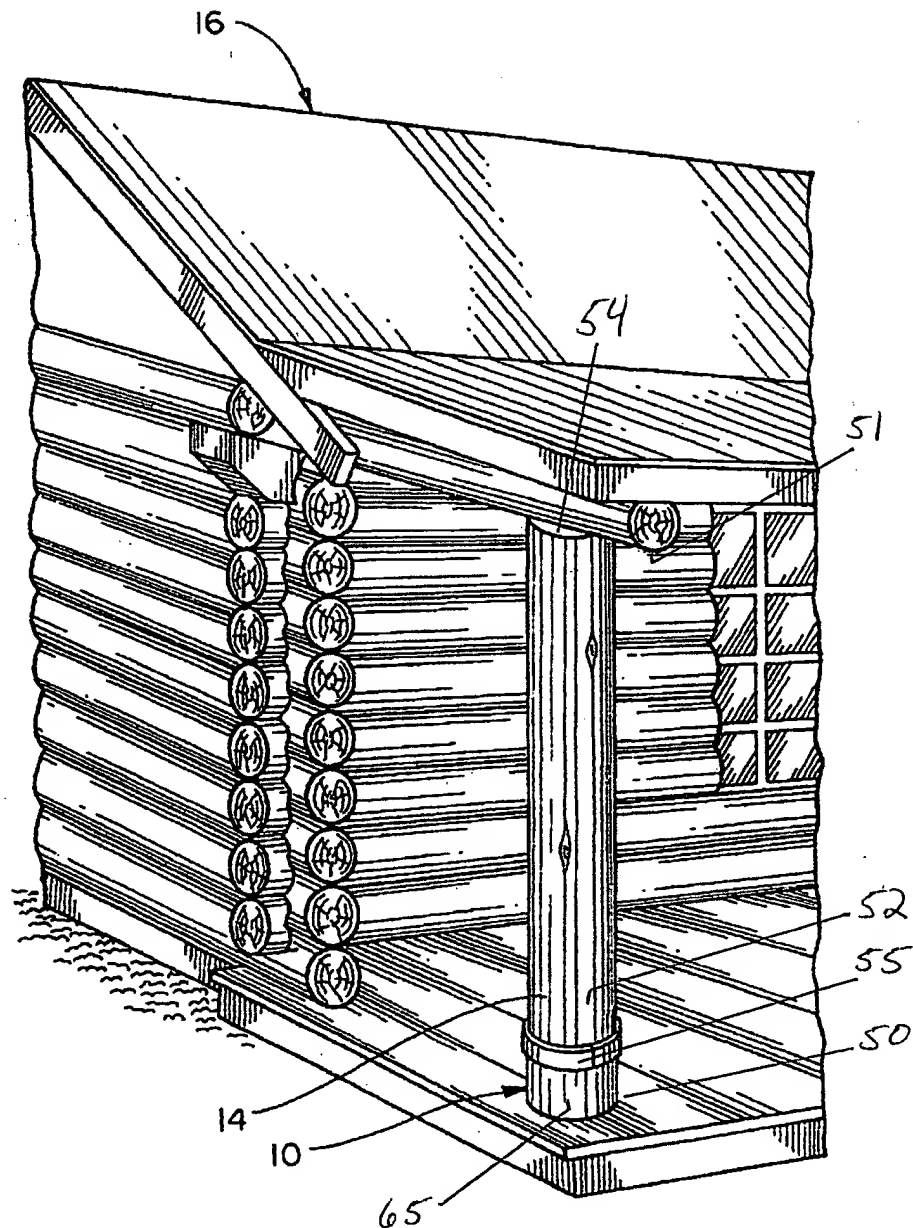


Fig. 1

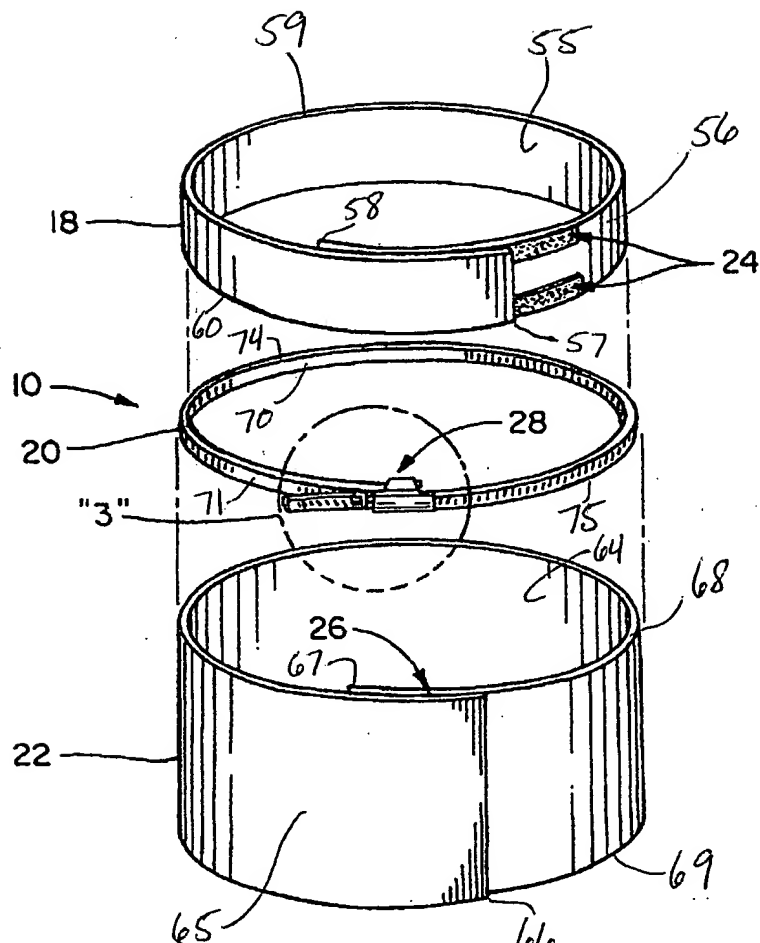


Fig. 2

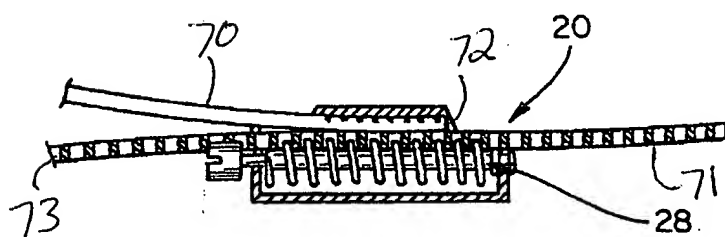


Fig. 3

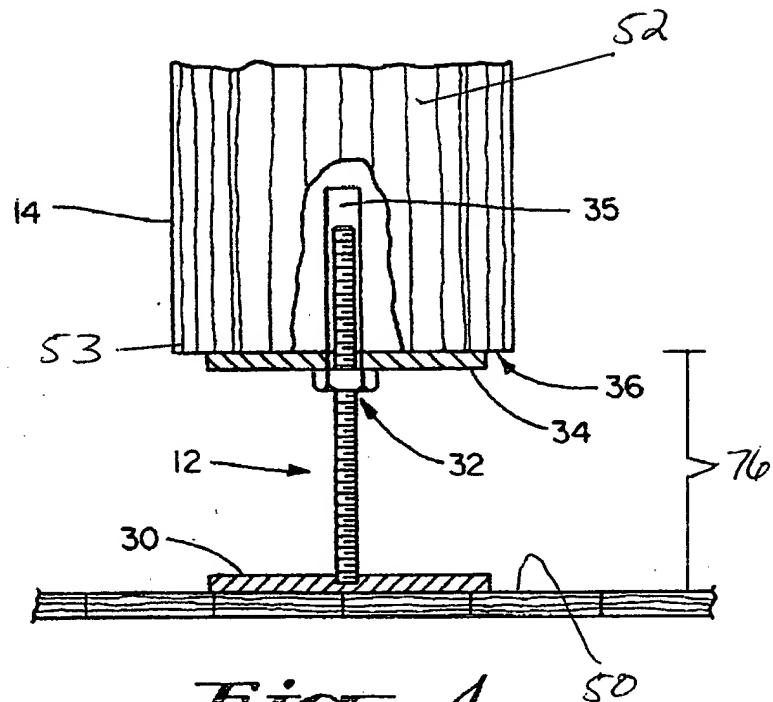


Fig. 4

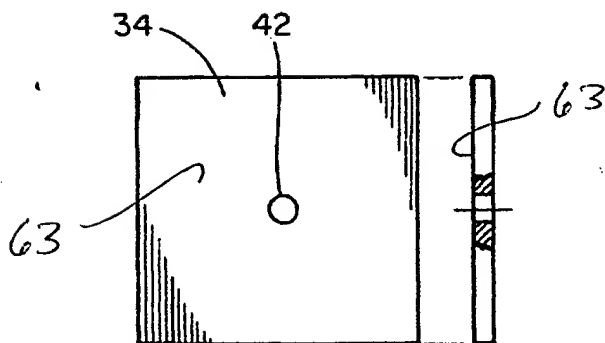


Fig. 5

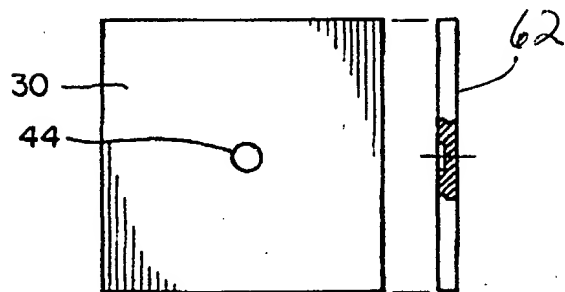


Fig. 6

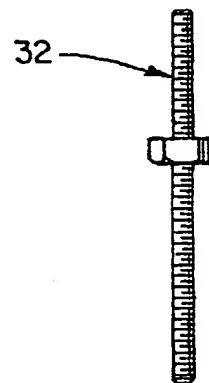


Fig. 7

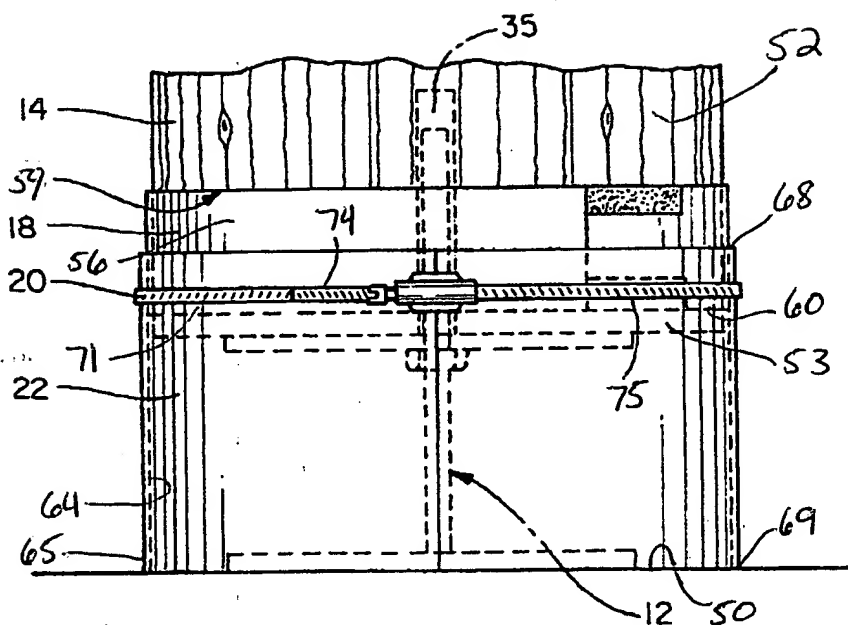


Fig. 8

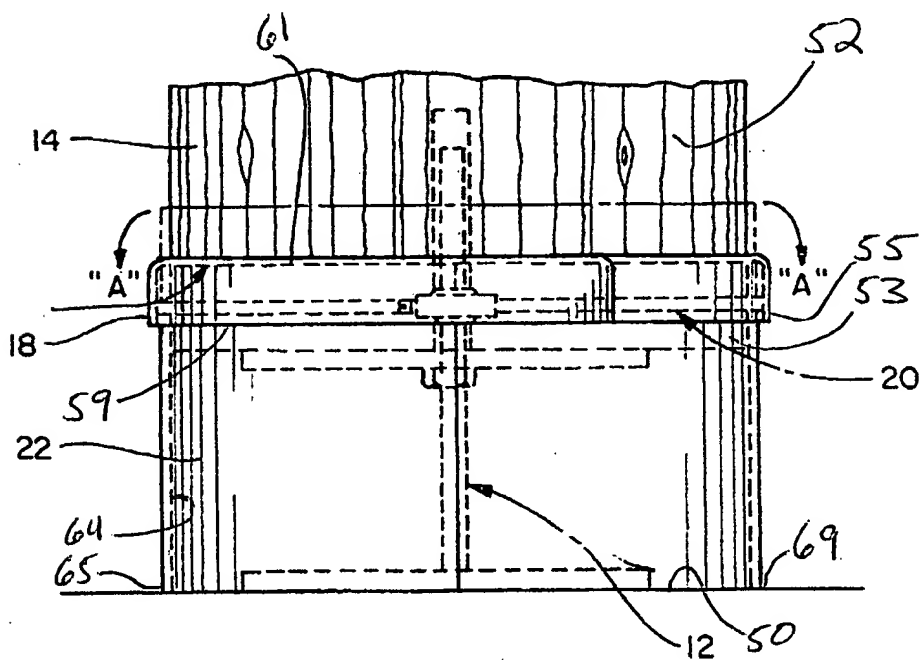


Fig. 9

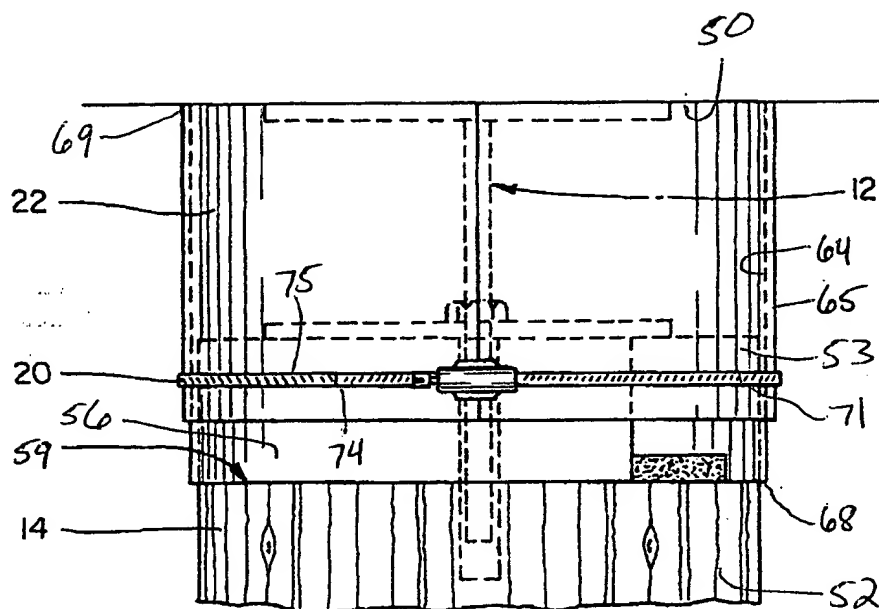


Fig. 10

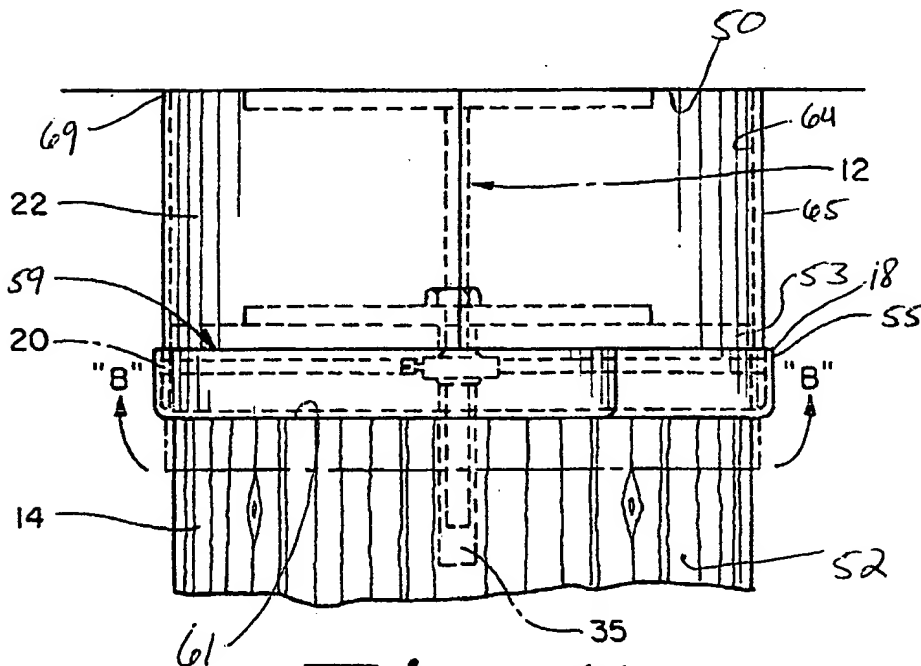


Fig. 11